

## **REMARKS**

This paper is submitted in response to the Office Action mailed on November 3, 2005. Claim 9 has been amended and claims 13-20 have been canceled. Claims 1-12 now remain in the application. In view of the foregoing amendment, as well as the following remarks, Applicants respectfully submit that this application is in complete condition for allowance and requests reconsideration of the application in this regard.

The application was originally filed with twenty (20) claims and was subject to a restriction requirement. In response to the restriction requirement, Applicants elected Group I, identified by the Examiner as being represented by claims 1-12. The non-elected claims 13-20 have been cancelled herein without prejudice to the filing of one or more divisional applications.

Claims 1, 2, 7 and 12 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Publication No. 2002/0113460 to Murakami et al. ("Murakami"). Claims 1, 2, 7 and 12 have also been rejected in the alternative under 35 U.S.C. § 103(a) as being obvious over Murakami. In regard to claim 1, the Examiner states:

Murakami et al. disclose an automotive interior trim assembly for coupling to an automobile, comprising: a substrate member (12) forming at least a part of a structural support of the trim assembly, said substrate member (12) forming at least a part of a structural support of the trim assembly, said substrate member (12) having a front surface (12a) adapted to face the interior of the automobile and a back surface adapted to face opposite said front surface; a connecting member (12b) integrally molded with said substrate member and extending away from said back surface (Fig. 3), said connecting member (12b) having an aperture (Fig. 3) formed therein; and a grommet (7a) integrally molded in said aperture and adapted to secure a wire (2c) to said connecting member (12b) so as to prevent

movement of the wire with respect to said substrate member (12).

(Office Action, p. 4). Applicants respectfully traverse the rejection.

Murakami discloses a modular construction of an automotive door frame. As shown in Fig. 3 of that reference, the vehicle door frame (10) includes an opening (10a) that faces the passenger compartment of the vehicle. The door frame (10) also includes a side panel (10b) that is configured to be adjacent to another portion of the vehicle body, such as for example through a hinged connection. The side panel (10b) includes a groove (10c) at an edge thereof. A door modular panel (12) is configured to be coupled to the door frame (10) so as to cover the opening (10a). The panel (12) includes a protruding member (12b) that extends toward the door frame so as to fit into groove (10c) of the side panel (10b) when the panel (12) is mounted thereto. Protruding member (12b) includes a harness hole (12c).

A wire harness (2) includes a first portion (1) wired to a front surface of the panel (12) that faces the passenger compartment and a second portion (2c) that is threaded through a panel hole (12d) so as to be adjacent a second surface of panel (12), i.e., behind the panel (12). The tip of second portion (2c) includes a grommet (7) having a hooking portion (7a), a corrugated tube (7b) and a connector housing (7c). The whole assembly is inserted into the harness hole (12c) such that the hooking portion (7a) is sealed in the harness hole (12c). The grommet (7) may also be mounted to the tip of second portion (2c) after the latter has been passed through harness hole (12c). The wire harness (2) is coupled with the panel (12) prior to the panel (12) being mounted to frame (10). This avoids having to thread the wire harness (2) through the

side panel (10b) of frame (10) and instead, the wire harness (2) is threaded through the harness hole (12c) prior to mounting the panel (12) to the frame (10).

Applicants respectfully disagree that Murakami teaches or suggests the combination of elements recited in independent claim 1. Claim 1 recites “a grommet integrally molded in said aperture.” There is no teaching in Marakami to indicate that the grommet (7) is in any way integrally molded with the harness hole (12c). Marakami discloses that the “the tip of the second portion 2c is mounted with a grommet 7, and the whole assembly is inserted into the harness hole 12c.” (Col. 5, Ins. 34-37).

Murakami further discloses “Alternatively, the grommet may be mounted around the tip after the latter has been passed through the harness hole 12c...” (Id. at Ins. 38-39). In either case, the grommet (7) is not integrally molded with the harness hole (12c) but is fitted within the harness hole (12c) as a separate, non-unitary piece. Accordingly, Applicants submit that Marakami does not teach the combination of elements recited in independent claim 1 under 35 U.S.C. §102(b) and the rejection should be withdrawn. Moreover, as claims 2, 7 and 12 depend from independent claim 1, Applicants submit that these claims are allowable as well.

The Office Action does not elaborate on how the Examiner arrives at a rejection of claims 1, 2, 7 and 12 under 35 U.S.C. § 103(a) based on Murakami and it appears that the Examiner has rejected these claims solely under 35 U.S.C. §102(b). In any event, Applicants respectfully submit that Murakami does not only fail to teach or suggest the integrally molded connection between the grommet and the aperture, but Murakami also fails to teach or suggest that such a connection may be made. As

discussed above, the portion of Murakami's disclosure discussing the connection between the grommet (7) and harness hole (12c) precludes the type of connection specifically recited in claim 1. Additionally, there is no teaching or suggestion of an integrally molded connection between the grommet and harness hole, nor is there any teaching or suggestion of how such a connection could be made. Accordingly, Applicants submit that Marakami does not teach or suggest the combination of elements recited in independent claim 1 under 35 U.S.C. §103(a) as well. Thus, the rejection should be withdrawn. Again, since claims 2, 7 and 12 depend from allowable claim 1, these claims are allowable as well.

Although it is not clear in the Office Action, the Examiner appears to assert that an integrally molded connection between the grommet and the aperture as recited in claim 1 is a product-by-process limitation. The Examiner states:

MPEP 2113 Product-by-Process Claims states that 'If the product in the product-by-process claim is that [sic] same as or obvious from a product of the prior art, the claim is unpatentable even through the prior art product was made by a different process.' The trim panel with a grommet is anticipated by Murakami et al. The process by which the grommet is made is not a patentable distinction.

(Office Action, p. 4). Applicants respectfully disagree that "a grommet integrally molded in said aperture" is completely devoid of any structural aspects or features so as to interpret such solely as a product-by-process recitation. A recitation that one body is integrally molded with another body not only intimates a type of process used to make such a connection but also describes the type of connection between the two bodies. The type of connection between two bodies is a structural feature. A clear example of a type of connection that is widely recognized as being structural in nature is an adhesive

connection. One would not say that a claim which recites that one body is adhesively coupled to another body implies a process by which the two bodies are coupled. To the contrary, such a recitation would more likely be viewed as a structural feature describing the type of connection between the two bodies. In a similar manner, “a grommet integrally molded in said aperture” is a structural feature describing the connection between the grommet and the aperture. Accordingly, Applicants submit that “a grommet integrally molded in said aperture” is not solely a product-by-process feature but also is a structural recitation that is not taught or suggested by Murakami as mentioned above. Thus, for this further reason, the rejection is improper and should be withdrawn.

Claims 3-6 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Murakami. Each of these claims depends from independent claim 1. Thus, for the reasons stated above regarding claim 1, Applicants submit that each of these claims recites a combination of elements not taught or suggested by Murakami and should be allowed.

Claims 8 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Murakami in view of U.S. Patent No. 5,927,020 to Kobrehel (“Kobrehel”). Although claims 8 and 9 depend from allowable independent claim 1 and therefore are allowable for that reason, claims 8 and 9 are allowable for additional reasons. In the Office Action, the Examiner states:

Murakami et al. disclose the trim assembly of claim 1.

Murakami et al. do not disclose that the aperture includes a slot portion wherein the wire is insertable in the slot.

Kobrehel discloses a trim assembly with a projection (Fig. 3) which includes a slot that the wire is inserted through.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include a slot in the projection to insert the wiring through. The motivation would have been to allow the wire to be easily removed and reinstalled. A natural result of the slot would be a grommet with a slot (Fig. 9). The motivation for the grommet slot would be to install the wiring.

(Office Action, p. 6). Applicants respectfully disagree.

Kobrehel is directed to a modular insert trim unit (10) for a motor vehicle door having a molded plastic door cavity insert (12) to which various hardware is mounted. As shown in Figs. 2 and 3 of that reference, a window regulator (14) is coupled to an outboard surface (18) of insert (12). An electric drive motor (16) is also mounted on outboard surface (18) and is in electrical connection with a wiring bus (17). Wiring bus (17) is coupled to surface (18) by an clip or attachment member (not numbered) as shown in Fig. 3. Wires (42, 54) run off of wiring bus (17) to power a solenoid (40) for the door handle and power lock system and sound speaker system (52).

In regard to claim 8, the Examiner does not present a *prima facie* case of obviousness. In particular, Murakami does not teach or suggest the combination of elements recited in claim 8 and Koebrehel does not teach or suggest a modification of Murakami that results in the invention of claim 8. As noted above, the Examiner acknowledges that Murakami does not disclose a slot portion in the protruding member. In addition, however, Murakami does not even suggest such a slot portion or even indicate any manner of inserting the wire through the harness hole other than by

threading an end of the wire harness therethrough. Murakami provides absolutely no reason or motivation for providing a slot portion in the protruding member through which the wire harness can be inserted so as to be positioned in the harness hole and grommet.

Kobrehel appears to show a snap fit attachment member in Fig. 3 which has an opening through which the wire bus may be inserted. The attachment member is not numbered in the drawing and the only disclosure relating to the attachment of the wiring bus to the outboard surface is: "Electric motor 16 is seen to be in electrical connection with wiring bus 17 which is secured to the outboard surface 18 of the door cavity insert 12." (Col. 5, Ins. 28-31). Based on Fig. 3 and this terse disclosure, the Examiner concludes that it would have been obvious to combine the teaching of Murakami with that of Kobrehel to arrive at the invention of claim 8. Combining references in this manner is improper and stretches the application of obviousness to unacceptable extremes.

Kobrehel appears to show in Fig. 3 a snap fit attachment member having an opening for inserting the wiring bus in a non-threading manner. There is no mention that a grommet may be positioned in the opening or text of any kind discussing the attachment member. One of ordinary skill in the art would not review these two references and come away with the conclusion that an opening may be made in the end of protruding member (12b) to provide for a snap fit attachment of the wire harness (2c) to the harness hole (12c) in a non-threading manner. Murakami teaches only threading the wire harness (2c) through the harness hole (12c). Kobrehel provides no advantages

or other recitations for the snap fit attachment member that would motivate one of ordinary skill in the art to modify Murakami in the manner suggested by the Examiner.

Instead, the Examiner's conclusion that it would have been obvious to modify Murakami by forming an opening in the end thereof for inserting the wire harness in a non-threading manner, is based on conjecture and improper hindsight reconstruction based on the Applicants' own disclosure. Thus, for this additional reason, the rejection of claim 8 under 35 U.S.C. § 103(a) is improper and falls short of a *prima facie* case of obviousness.

In regard to claim 9, the claim has been amended to depend from claim 8 and further amended to recite "a first slit therethrough and extending across said grommet so as to intersect a periphery of said grommet..." Murakami does not teach or suggest a slit in the grommet that intersects the periphery of the grommet. Additionally, Kobrehel does not teach or suggest a grommet, let alone a grommet having a slit that intersects a periphery of the grommet. Moreover, there is no motivation in Murakami or Kobrehel to modify the grommet in Murakami to have such a slit configuration. Thus, for this additional reason, claim 9 should be allowable.

Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Murakami in view of Kobrehel and in further view of U.S. Patent No. 6,953,897 to Marroquin et al. ("Marroquin"). Claim 10 depends from claim 9 and for the reasons stated above for claims 1, 8 and 9, Applicants submit that claim 10 should be allowable.



### **Conclusion**

In view of the foregoing response including the amendments and remarks, this application is submitted to be in complete condition for allowance and early notice to this affect is earnestly solicited. If the Examiner believes any matter requires further discussion, the Examiner is respectfully invited to telephone the undersigned attorney so that the matter may be promptly resolved.

Applicant does not believe that any fees are due in connection with this response. However, if such petition is due or any fees are necessary, the Commissioner may consider this to be a request for such and charge any necessary fees to deposit account 23-3000.

Respectfully submitted,

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